REMARKS

In response to the Office Action dated April 9, 2003, claims 1 and 18 have been amended. Claims 1-16 and 18 are in the case. The Applicant respectfully requests that the present amendment be entered in this case. Reexamination and reconsideration of the present application is kindly requested.

The Office Action rejected claims 1-16 and 18 under 35 U.S.C. §103(a) as being unpatentable over Daniels (U.S. Patent No. 6,373,500) in view of Jakobs et al. (U.S. Patent No. 5,892,509).

The Applicants respectfully traverse this rejection based on the arguments below and the amendments to the claims. Namely, the claims include manipulating and sharing data displayed on the display device between a first window of a first computer and a **picture within a picture window** of a second window of a second computer **through a common memory buffer**.

However, the cited references, when combined, are missing at least one material limitation of the Applicants' claimed invention. It is well settled that when the Examiner evaluates a claim for determining obviousness, all limitations of the claim must be evaluated. If the combination of references do not produce are missing limitations of the Applicant's claimed invention then a prima facie showing of obviousness does **cannot** exist. In Re Evanega, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987). In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Specifically, the Daniels reference merely discloses a system with "...a switchbox that can be used to simultaneously display the output of two computers on a single monitor..." Although the Examiner stated that "...Daniels teaches a user can use the input device (50) to move the cursor between the first window (36) and the second window (37)..." when rejecting the claims, this statement is erroneous. This is because Daniels explicitly states that "...when the user desires to reverse the main display area 36 and the PIP window 37, the cursor is positioned over the PIP window 37 by manipulation of the mouse 50 and a control click, such as for example a double click, will signal the controller 310 and PIP display circuit 130 to reverse the main display area 36 and PIP window 37 at 520 of FIG. 7B..." at col. 5, lines 44-49.

Therefore, the input device in Daniels is using the cursor in this instance to simply "reverse the main display area" and **not** to share and manipulate data between

windows. As such, since the Examiner's interpretation of Daniels et al. is erroneous, any combination of Daniels et al. with the Jakobs et al. reference, regardless of whether or not a common memory buffer is disclosed, will still **not** render the Applicants' invention obvious. In Re Evanega.

Moreover, even though the combination of Daniels et al. and Jakobs et al. do **not** produce all of the elements of the claimed invention, as discussed above, these references **should not** even be considered together since there is no motivation to combine the cited references. It is well-settled law that there **must be** a basis in the references for combining or modifying the references. The Examiner **cannot** arbitrarily "pick and choose" elements from numerous references and combine these elements without some basis.

Specifically, Jakobs et al. teaches away from the Applicants' claimed invention. Although Jakobs et al. disclose "...coupling at least two image processing systems connected to a network..." and using "...both common and personal memory...", **its use of the common memory teaches away** from the Applicants' claimed invention. Namely, Jakobs et al. explicitly states that "...[T]he personal memory of each system contains one or more personal images that can be viewed **only** by the respective system...and that "...each system is controlled to access **only** its respective personal memory. [*emphasis added*].

Further, "...**a common image** is coupled to each system over the network and commonly displayed on each system..." however, although "...the common image is commonly displayed on each system, **it is edited by the first image processing system**..." [*emphasis added*]. In contrast, the Applicants' claimed invention does **not** have such constraints because it allows manipulation and sharing of data between a first window of a first computer and a **picture within a picture window** of a second computer with a display device **through a common memory buffer**.

As such, this "teaching away" cannot be ignored by the Examiner. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.. Namely, "it is impermissible within the framework of 35 U.S.C. 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly

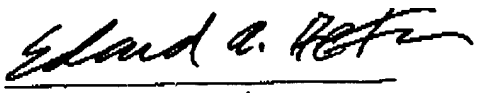
suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1965).

Consequently, obviousness cannot be established by combining these references. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). This **failure** of the cited references, either alone or in combination, to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (*MPEP 2143*).

Further, because the dependent claims depend from the above argued independent claims, and contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable over these references.

In view of the arguments and amendments set forth above, the Applicants respectfully submit that the claims of the subject application are in immediate condition for allowance. The Examiner is respectfully requested to withdraw the outstanding claims rejections and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns.

Respectfully submitted,
Dated: July 9, 2003



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

The following are marked-up versions of claims 1 and 18:

1. (Twice Amended) A method for operating plural computers displayed on a display device having at least a first window that displays information from a main computer and a second window that displays information from a remote computer, comprising:

controlling data from the main computer and the remote computer with an input device associated with one of the computers; and

manipulating and sharing data displayed on the display device between the first window of the main computer and a picture within a picture window of the second window of the remote computer through a common memory buffer.

18. (Twice Amended) A method of editing data between first and second computer systems, the data from the first and second computer systems being displayed on one monitor, the method comprising:

connecting the monitor to the first computer system;

connecting the monitor to the second computer system; [and]

displaying a first window with data from the first computer and a second window with data from the second computer; and

editing and sharing data between [a] the first window of the first computer system and a picture within a picture window of the second window of the second computer system through a common memory buffer.